

### **REMARKS**

Applicant and the undersigned thank Examiner Refai for a careful review of this application. Consideration of the present application is respectfully requested in light of the above amendments to the claims, and in view of the following remarks.

#### **Status of the Claims**

After entry of the foregoing amendments, Claims 1-10, 12-21, 23-35, 37-47, and 49-59 are pending in the present application. Claims 1, 15, 26, 40, and 56 are the independent claims. Applicant has canceled Claims 11, 22, 36, and 48 without prejudice to, or disclaimer of, the subject matter recited therein. Applicant has added new Claims 52-59 to provide an additional scope of protection commensurate with the original disclosure. Additionally, Applicant has amended Claims 1, 12, 15, 18, 26-27, 31-33, 35, 40-41, 44-45, and 47 herein. No new matter has been added.

#### **Claim Rejections Under 35 U.S.C. § 103(a)**

In the Office Action dated November 9, 2004, the Examiner rejected Claims 1-51 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,092,114 to *Shaffer et al.* ("*Shaffer*") in view of U.S. Patent No. 6,311,058 to *Wecker et al.* ("*Wecker*"). Applicant respectfully traverses that rejection.

#### **Independent Claims 1, 15, 26, and 40, as Amended, are Patentable over *Shaffer* and *Wecker***

Applicant submits that none of the documents cited by the Examiner, either alone or in combination, teach or suggest at least the feature of converting image data to a plurality of image files in a second file format, each one of said plurality of image files limited to a size that is less than or equal to the maximum file size capable of being

received by the end-use-device, as presently recited in amended, independent Claims 1, 15, 26, and 40.

In the Office Action, the Examiner points to col. 4, lines 25-44 of *Shaffer* as allegedly disclosing the step of converting image data in a second file format, limited to a specified size, wherein the specified file size is determined by a maximum file size capable of being received by said end-use-device. Applicant respectfully submits that, though *Shaffer* arguably discloses converting the file format of an electronic mail attachment to a second file format (col 2, lines 30-40), it fails to disclose at least the feature that each file in the second file format is limited to a size that is less than or equal to the maximum file size capable of being received by the end-use-device, as required by the amended, independent Claims 1, 15, 26, and 40.

Applicant respectfully submits that *Shaffer* merely discloses converting the file format of an electronic mail attachment to a second file format upon a determination that the file format capabilities of the client device to which the attachment is to be transferred do not match the access requirements of the attachment in its original file format. (col 2, lines 34-40). As Applicant understands, *Shaffer* discloses determining whether a client device can access an attachment without conversion of the attachment from an original file format to a second file format. (col 8, lines 42-44). If the client device cannot access the attachment without a file format conversion, then, prior to transferring the electronic message to the client device, the file format may be converted to a different format at the server level. (col 4, lines 47-52).

Applicant respectfully submits that simply converting an attachment from an original file format to a second file format does not address the problem to which Applicant's invention is directed, namely receiving image data on a remote device with limited file size reception capabilities. In particular, Applicant submits that *Shaffer* does

not contemplate, teach, or suggest at least the feature of, converting image data to a plurality of image files in a second file format, wherein the size of each file in the second file format is limited to a size less than or equal to the maximum file size capable of being received by the end-use-device, as required by amended, independent Claims 1, 15, 26, and 40. Applicant further submits that none of the other documents cited by the Examiner teach or suggest that feature.

New Independent Claim 56 is Distinguishable from the Cited Prior Art

In addition, Applicant submits that none of the documents cited by the Examiner teach or suggest at least the features of (1) reformatting the image data in a second file format by at least one of resizing the image and altering the color scheme of the image and (2) converting the image data to a plurality of image files in a third file format, each one of the plurality of image files limited to a size that is less than or equal to the maximum file size capable of being received by the end-use-device, as recited in new independent Claim 56.

Thus, Applicant submits that independent Claims 1, 15, 26, 40, and 56 are patentable over the documents cited by the Examiner. Additionally, the remaining claims depend from Claims 1, 15, 26, 40, and 56, and are submitted to be patentable for similar reasons. The dependent claims also recite additional features further defining the present invention over the cited documents, and Applicant submits that the cited documents do not teach or suggest integrating those features into the presently claimed invention. Accordingly, Applicant requests separate and individual consideration of each dependent claim.

**Additional Prior Art**

Applicant acknowledges the additional prior art of record, but has not discussed any of those references because they were not relied upon by the Examiner in forming the above-mentioned rejections.


**Change of Correspondence Address**

On January 5, 2005, ChoicePoint Inc., the owner by assignment of all right, title, and interest in and to the subject application, filed with the Patent Office a revocation of all powers of attorney previously granted for the application and an appointment of the practitioners associated with **Customer Number 20786** as the attorneys of record therefor. Please direct all future correspondence in the application to **W. Scott Petty** at the address associated with that customer number.

**CONCLUSION**

The foregoing is submitted as a full and complete response to the Official Action mailed November 9, 2004. All additional fees believed to be due are enclosed herewith. However, the Commissioner is hereby authorized to charge any additional fees due or credit any overpayment to Deposit Account No. 11-0980. If there are any issues which can be resolved by telephone conference or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney at (404) 572-2888.

Respectfully submitted,



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